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Technology Center 2100

Appellants: Mustansir Banatwala and Jorge Camargo

Application No.: 08/781,696 Group Art Unit: 2178

Filed: January 10, 1997 Examiner: Cesar B. Paula

For: COMPUTER METHOD AND APPARATUS FOR PREVIEWING FILES
OUTSIDE OF AN APPLICATION PROGRAM

#27 SC
3/26/03

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REPLY BRIEF

Box AF
Assistant Commissioner for Patents
P.O. Box 2327
Arlington, VA 22202

Sir:

This Reply Brief is submitted under 37 C.F.R. §1.193(b)(1) pursuant to the Examiner's Answer mailed from the U.S. Patent and Trademark Office on January 13, 2003, and in support of the appeal from the final rejection(s) set forth in the Final Office Action mailed on April 22, 2002.

Regarding section (7), Examiner's Grouping of the Claims, the Examiner contends that "[t]he following groups of claims stand or fall together: (1, 7, and 12), (1, and 2), (12, and 16-17), (3, 8, and 13), (4, 9, and 14), (5, 10, and 15), (6, 11)." Appellants agree that the following groups of claims stand or fall together: (3, 8, and 13), (4, 9, and 14), (5, 10, and 15), (6, 11), but that independent Claims 1, 7, 12 and dependent Claims 2, 16 and 17 do not stand or fall together with any other claim or group of claims.

Regarding section (10), Grounds of Rejection, Appellants continue to believe that there are misunderstandings of the distinctions of the present inventions over the cited prior art, including the following.

The terms "internal file characteristics" and "internal file contents" seem to be used interchangeably by the Examiner, when in fact they are different (*cf.* Examiner's Answer, page 4, line 3 and Examiner's Answer page 6, lines 7-8). Internal file characteristics refer to an attribute or property of the file image (e.g., its height, width, length, color type, resolution, compression type used for storing and/or forming the file image), not to the displayable file image itself. Internal file characteristics of the present invention are obtained by opening and reading the file, not by decoding a filename or reading a file allocation table (FAT) entry. In contrast to internal file characteristics, internal file contents refer to the file image itself that is stored in the file. File image data is distinct from internal file characteristics. Internal file characteristics comprise meta-data, or data about the file image data. The distinction between the two different types of data is important and is reflected in the claims language "enabling display of a recitation of indicia of internal file characteristics separate from the file image...", as recited in Claims 1, 7 and 12.

Further, the need to open the file itself in order to acquire the internal file characteristics does not seem to be recognized by the Examiner. The Examiner points to Fig. 8 of Windows NT Explorer screen dumps to show "the indication of [internal] file characteristics" (see Examiner's Answer, page 6, lines 7-8), but Fig. 8 actually discloses that the file characteristics were derived from the file type (e.g., ZIP) of the file image file.

Regarding section (11), Response to Arguments, Appellants continue to contend that there is no suggestion to combine the cited references, that the combination of the cited references lacks a reasonable expectation of success and that the combination of the cited references does not teach all the claim limitations.

While the Examiner admits that "Windows NT Explorer fails to explicitly disclose: displaying the recitation of indicia of internal file characteristics separate from the file image" (Examiner's Answer, page 8, lines 19-21), the Examiner contends that "[i]t would have been

clearly obvious to a person of ordinary skill in the art at the time of the invention to combine the teachings of Windows NT Explorer and PhotoImpact..." (Examiner's Answer, page 9, lines 2-4). The Examiner attempts to support the integration of PhotoImage and Windows NT Explorer by stating that "PhotoImpact has to interact with the operating system to access files in such operating system" (Examiner's Answer, page 16-17), but interaction with an operating system, which all applications must do, is not equivalent to integration with an operating system. The present invention is "entirely integrated with the operating system" (Claim 1), "coupled to the operating system" (Claim 7) or an "operating system means" itself (Claim 12). Each of these limitations implies an integration beyond mere interaction or affiliation (to use the Examiner's words) with the operating system. Integration requires a solution to overcoming the technical obstacle of converting software written for one environment (e.g., an application program) to, or from, a different environment (e.g., an operating system extension). That solution was not obvious to a person of ordinary skill at the time of the invention and is not suggested by any of the cited prior art. The sheer desire to add functionality to a program (i.e., the operating system), as opposed to the obviousness of adding functionality to a program (operating system), where obviousness takes into account the technical difficulty, as well as the desire, is not a distinction that the Examiner makes in rejecting the claims of the present invention.

At page 9, lines 18-20 of the Examiner's Answer, the Examiner states that "[m]oreover, the Examiner disagrees with Appellant's argument that PhotoImpact is an application program not affiliated with the operating system (p.6, l.3-5). PhotoImpact has to be affiliated with the operating system it runs under." This statement is in direct contrast to the Examiner's statements in the Final Office Action dated April 22, 2002, page 8, lines 18-19 and the Examiner's Answer, page 10, lines 16-17, where the Examiner stated "PhotoImpact is an application for processing images, and which is not affiliated with the operating system (Examiner's emphasis added). Affiliation or interaction is not the same as integration with an operating system. Neither the cited prior art, nor a person of ordinary skill at the time of the invention, provide support for a reasonable expectation of success with respect to integrating (e.g., converting to an operating system extension) an application program (e.g., PhotoImpact) with an operating system.

Conclusion

Independent Claims 1, 7 and 12 recite the limitations of the respective extension, file manager coupled to the operating system, or operating system means, entirely integrated with the operating system “sharing a user interface with the operating system...enabling display of a recitation of indicia of internal file characteristics separate from the file image...by opening the desired file in a manner free of opening an application program”.

Since all the limitations of Claims 1, 7 and 12 are not taught, suggested or otherwise made obvious by the cited art (Explorer and Photoimpact) Claims 1, 7 and 12 are believed to be patently distinguishable over the cited art. Therefore, Appellants respectfully request withdrawal of the rejection of Claims 1, 7 and 12 under 35 U.S.C. 103(a).

Claims 2-6, 8-11 and 13-17 are dependent on amended base Claims 1, 7 and 12, respectively. The above remarks regarding amended Claims 1, 7 and 12 apply to dependent Claims 2-6, 8-11 and 13-17 by virtue of the fact that, if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Where neither Explorer nor Photoimpact discloses operating system means (e.g., an extension or file manager) which, in a manner free of opening an application program, provides display of internal (not external) file characteristics, no combination of these references suggest the claimed invention. Further, where Photoimpact is an application program for displaying internal file characteristics, it runs counter and opposite from (or at least teaches away from) the Explorer Quick View features of displaying external file characteristics and sharing a user interface with the Windows operating system. Thus, Explorer and Photoimpact is not a proper combination to suggest, or make obvious, the present invention. Therefore, Appellants respectfully request withdrawal of the rejection of Claims 2-6, 8-11 and 13-17 under 35 U.S.C. 103 (a).

In view of the above arguments, it is respectfully requested that the rejection of Claims 1-17 be reversed such that the claims are allowed, and the application be passed to issue.

Respectfully submitted,

HAMILTON, BROOK, SMITH & REYNOLDS, P.C.

By C. Steven Kurlowicz

C. Steven Kurlowicz

Registration No. 46,846

Telephone: (978) 341-0036

Facsimile: (978) 341-0136

Concord, MA 01742-9133

Date: 3/12/3